REMARKS

Applicant amends claims 1, 7, and 13. Claims 1-20 remain pending in the application, with claims 1, 7, and 13 being in independent form.

In an Office Action[1] the Examiner took the following actions:

> rejected claims 1, 7, and 13 under 35 U.S.C. § 112, second paragraph;
>
> rejected claims 1-6 under 35 U.S.C. § 101; and
>
> rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,148,291 to Radican ("*Radican*") in view of U.S. Patent No. 5,216,620 to Sansone ("*Sansone*"), and further in view of U.S. Patent No. 6,746,164 Albright et al. ("*Albright*").

§ 112 Rejection

In the Office Action, the Examiner rejected claims 1, 7, and 13 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Office Action at 3. In an effort to advance prosecution, Applicant has amended independent claims 1, 7, and 13 to recite that the "the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label." The inclusion of this claim element is supported by the specification at, for example, paragraphs 29, 72, and 73. Applicant also respectfully disagrees with the Examiner's characterization of paragraph 73 at page 4 of the Office Action, as this paragraph, along with paragraph 72, discusses how enhanced labels are

[1] The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

generated so as to be unique within a predetermined time period, including a discussion of an exemplary 30-day predetermined time period:

> FIG. 11 is a table 1100 illustrating exemplary constant, key, and variable barcode data elements for each of the label types in table 810 of FIG. 8 consistent with the present invention. **Each label 120 provides a concatenated routing code and unique identifier in the barcode for a specific timeframe for each label type, as illustrated in table 810 of FIG. 8. Consistent with the present invention, a serialization strategy is provided to define how each of the label types of table 810 provides uniqueness. For each label type of table 810, uniqueness may be defined in terms of constant, key, and variable fields in the barcode. Constant fields are those that stay the same due to, for example, the origin of the mail or the source of the tray label. Key fields are fields that vary, but are not at the control of the originator. Thus, key fields may be used to ensure uniqueness. Variable fields are fields where the originator of the mail may exercise control and may be considered the most effective means of guaranteeing uniqueness.**
>
> The printing system of the present invention does not need to utilize the key fields in generating unique labels for trays and sacks. **For example, in a situation with a 30 day uniqueness requirement, if a mailer having its own 7-digit Mailer ID only generates 100,000 trays per month, the mailer only needs to increment the variable Serial Number field for each successive label. If, however, the mailer generates 1,800,000 trays using various ZIPs and CINs, the mailer's printing system could choose to track the changes in CIN or ZIP key fields in determining when it may need to increment the variable Serial Number field. Once the length of uniqueness is defined, maintaining uniqueness of the tray identifier for its entire life may be accomplished through serialization management.** (Emphasis added.)

Paragraph 29 provides further support for this claim element:

> FIG. 1 is an illustration of a system consistent with the present invention in its operating environment. A handler 110a in a mail processing facility may utilize a label printer system 105 to generate an enhanced label 120c. Enhanced label 120c may comprise a routing code and a label unique identifier, either as a single concatenated code or as individual codes. Such codes may be in the form of a bar code, with or without a human readable format. Enhanced label 120c is placed onto a tray 125 in order to uniquely identify tray 125. **Uniquely identifying tray 125 should not be construed as requiring an absolutely unique identifier for tray 125, but, as is understood by those skilled in the**

> **art, as sufficiently unique enough to distinguish tray 125 from other trays within a reasonable time period, e.g., within a one year time frame**. (Emphasis added.)

In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 7, and 13 under 35 U.S.C. § 112.

§ 101 Rejection of Claims 1-6

In the Office Action the Examiner rejected claims 1-6 under 35 U.S.C. § 101 because, according to the Examiner, "applicant's method steps are not tied to a particular machine and do not perform a transformation." Office Action at 5. Applicant disagrees with the Examiner and respectfully traverses this rejection. First, Applicant's claim 1 recites "generating an enhanced label," which constitutes the requisite transformation of subject matter to a different state or thing. Moreover, as amended, Applicant's claim 1 recites "printing the enhanced label and applying the enhanced label to the tray," which further constitute a transformation of subject matter to a different state or thing. In view of the above, Applicant respectfully requests that the § 101 rejection be withdrawn.

§ 103(a) Rejection of Claims 1-20

In the Office Action the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over *Radican* in view of *Sansone* and further in view of *Albright*. Applicant respectfully traverses this rejection.

Claim 1, as amended, recites a method of tracking a tray of items, including, amongst other elements, "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, **wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the**

predetermined time period are distinguishable from the enhanced label." (Emphasis added.) *Radican*, *Sansone*, and *Albright*, considered independently or in combination, do not teach or suggest at least this element of independent claim 1.

Radican discloses the use of unique designators and unique identification using a code or number:

> As further shown in FIG. 1, **each receiving area Y is assigned a unique designator such as Y1, Y2, etc. Each of the docks are uniquely designated such as D1, D2, etc. Movers of shipping containers, and each shipping container is also uniquely identified by a code or number**. . . . **Each of the containers are assigned an individual code (usually numeric) which is combined with the SCAT code to identify every carrier/container combination**. This combination of codes is used to track containers and monitor carrier performance. . . . With coded identification of all carriers and containers, control over facility boundaries, and means for recording status and location of containers within a facility boundary, the system has the basic framework for compiling detailed data on the shipping process which can be used by the facility, suppliers and carriers to optimize logistics. *Radican*, col. 4, l. 55 - col. 5, l. 10 (emphasis added).

Radican also discloses the use of RFID tags and readers that "encode[] carrier and container identification data" for "rapid acquisition and updating of container location and status." *Radican*, col. 13, ll. 18-30.

However, *Radican* does not teach or suggest "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, **wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label**" as is recited in claim 1 (emphasis added). This is at least because *Radican* does not disclose, teach, or suggest, requiring unique designators to be unique "within a predetermined time period."

Neither *Sansone* nor *Albright* cures this deficiency of *Radican*. *Sansone* discloses that "a label is printed that identifies the mail in [a] tray for subsequent routing" *Sansone*, col. 1, ll. 49-51. *Sansone* also discloses label 29 and tag 32 that include various information:

> [L]abel 29 includes information identifying the mailer 50 and his location including his first three zip code digits, the destination of the tray 52 and the zip code thereof 54, the airport 56 to which the tray is to be sent, and the tray contents 58 including the class of mail, zip code information and degree of sortation. In addition, a bar code 60 in included that contains all the information shown in alphanumeric form.
>
> FIG. 2b shows a tag 32 having the destination 50 of the tray, the first three digits of the zip code 52, the class of mail 54, 56 and the identification number 57 of the contract between the post office 14 and the common carrier 38 at the upper portion thereof. At the lower portion is shown the dock number 59 where the tray is to be routed, the airline and flight number 58, the routing information 60, time of departure 62, expected time of arrival 64, and the weight in pounds of the individual tray and total weight of all trays 66 on the particular flight. The tag 32 also contains a bar code 68 that contains all the information given in alphanumeric form. It should be noted that the data on the label 29 is different from the data on the tag 32 for illustration purposes. *Sansone*, col. 4, ll. 21-43.

Sansone, however, does not teach or suggest "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, **wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label**" as is recited in claim 1 (emphasis added). This is at least because, *Sansone* does not disclose, teach, or suggest, the use of enhanced labels that "are unique within a predetermined time period."

Albright discloses the printing of "unique bar code[s] which the operator can use to identify each label" (col. 4, ll. 19-21, see also col. 5, ll. 35-47). However, *Albright*

does not teach or suggest "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, **wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label**" as is recited in claim 1 (emphasis added).

For at least the above reasons, *Radican*, *Sansone*, and *Albright*, considered alone or in any reasonable combination, do not teach or suggest at least the above-discussed recitations of amended independent claim 1. Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Nor does the Office Action clearly articulate a reason why amended claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1, as well as its dependent claims 2-6 and 19 under 35 U.S.C. § 103(a). Dependent claims 2-6 and 19 are also allowable by virtue of reciting additional elements neither taught nor suggested by the cited references.

Although different in scope from claim 1 and from each other, claims 7 and 13 each recite an "enhanced label [that] is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label." As discussed above in connection with claim 1, *Radican*, *Sansone*, and *Albright*, considered alone or in combination, do not teach or suggest at least this element. Thus, Applicant respectfully requests that the Examiner withdraw the

rejection of independent claims 7 and 13, as well as their respective dependent claims under 35 U.S.C. § 103(a). Dependent claims 8-12, 14-18, and 20 are also allowable by virtue of reciting additional elements neither taught nor suggested by the cited references.

Conclusion

In view of the above, Applicant respectfully requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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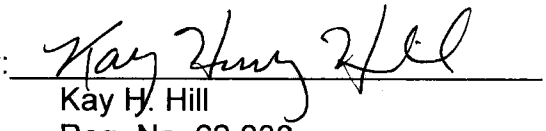
GARRETT & DUNNER, L.L.P.

Dated: May 3, 2010

By: 
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